

## REMARKS

### I. Summary of Office Action

The abstract of the disclosure was objected to under 37 C.F.R. § 1.72(b) for exceeding 150 words.

Claims 1, 2, 3, 6, 8, 9, 15, 16, 18, 19, 26-36, 39-42, 48, 49, 51, 55, 56, 63-72, 76-79, 85, 86, 88, 89 and 96-102 were rejected under 35 U.S.C. § 102(b) as being anticipated by Handelman European Patent Application Publication No. 0 620 688 A2 (hereinafter "Handelman").

Claims 4, 5, 10-14, 17, 20-24, 37, 38, 43-47, 50, 57-61, 73-75, 80-84, 87, 90-94, 103 and 104 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Handelman in view of Schein et al. PCT Publication No. WO 97/48230 (hereinafter "Schein").

Claims 25, 62 and 95 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Handelman in view of Schein in further view of Brenner et al. U.S. Patent No. 5,830,068 (hereinafter "Brenner").

Claims 52, 53 and 54 were found to allowable.

### II. Summary of Reply to Office Action

Applicants amended the abstract of the disclosure. Claims 13, 14 and 16 have been amended to correct an antecedent basis issue. Claims 51-54 and 73 have been cancelled.

The rejections under § 102 and § 103 are respectfully traversed.

### III. Reply to the Objection of the Abstract

The abstract of the disclosure was objected to under 37 C.F.R. § 1.72(b) for exceeding 150 words. The Office Action required correction. (See Office Action, page 2). Applicants

amended the abstract by deleting the last sentence. The abstract is now less than 150 words. Accordingly, applicants request that the rejection to the abstract of the disclosure be withdrawn.

IV. Reply to the Rejections of the Claims

The present application is a divisional patent application of application no. 09/522,227, now U.S. Patent No. 6,735,487 (hereinafter "parent application"). During the prosecution of the parent application, applicants received a substantive examination of the application until all the claims were placed in allowable form. All of the claims were placed in allowable form by either: (1) the October 7, 2002 Office Action finding an independent claim to be allowable; or (2) applicants amending a rejected independent claim in the February 7, 2003 Reply to Office Action to include a dependent claim feature that the October 7, 2002 Office Action found to be allowable. Following the February 7, 2003 Reply to Office Action, where all claims were placed in allowable form, the parent application was subject of a two-way restriction requirement in the May 2, 2003 Office Action. Applicants responded to the restriction requirement by electing the first claim group. Shortly thereafter, a notice of allowance issued, and as indicated above, the parent application has now issued as U.S. Patent No. 6,735,487. All of the claims in the second claim group were filed in the present divisional patent application.

Despite the claims in the divisional patent application previously being placed in allowable form in the parent application, the current Office Action has now issued a

rejection of these claims. Applicants submit that at least because these claims were placed in allowable form in the parent application, the claims should be found allowable in the present divisional application. Applicants provide the following remarks to clarify why each independent claim should be allowed.

When applicants filed the present divisional patent application, applicants renumbered the claims to be consecutive in an attempt to simplify the numbering. It appears that this may have confused matters. In rejecting some of the claims, the present Office Action relies on language in the claims prior to amendments being made in the parent application. In fact, the present Office Action uses similar, if not identical, language used in the parent application's first Office Action dated January 30, 2002. As indicated above, since the January 30, 2002 Office Action, applicants have either provided arguments or amended the claims to place the claims in allowable form. Additionally, in the present Office Action, some of the claims have been rejected for features not present in those claims, but rather for features that are in other claims. It is for this reason in particular that applicants believe the renumbering of the claims may have confused matters.

As a point of reference, applicants have provided a chart below with the independent claim number in this case and its equivalent independent claim number in the parent application. The claims are grouped together in the chart with their corresponding method, system and machine readable medium claims.

Claim Number in Present Divisional Application (Application No. 10/823,803)	Corresponding Claim Number in Parent Application (Application No. 08/522,227)
1, 34, 70	1, 42, 82
18, 55, 88	23, 64, 104
31, 68, 101	28, 69, 109
32, 69, 102	35, 76, 116
33, 103, 104	41, 122, 123

Applicants traverse the rejections presented in the Office Action.

A. Claims 1, 34 and 70

Claims 1, 34, and 70 in the present divisional application correspond with claims 1, 42 and 82, respectively, in the parent application. In the parent application, the October 7, 2002 Office Action rejected parent application claims 1, 42 and 82, but found their dependent parent application claims 4, 45 and 85, respectively, to be allowable. To place the claims in condition for allowance, the February 27, 2003 Reply to Office Action amended parent application claims 1, 42 and 82 to include the features of their dependent parent application claims 4, 45 and 85, respectively. Claims 1, 42 and 82 were then withdrawn from the parent application in response to the May 2, 2003 Restriction Requirement. These claims, in their allowable form, were filed in the divisional patent application as claims 1, 34 and 70.

Claims 1, 34, and 70 are directed towards a method, system and machine readable medium for promoting an opportunity for a user to interactively wager on races with an interactive wagering application implemented on user equipment. Television programming on the user equipment is displayed and a notification is automatically displayed as an overlay on top of the television programming that informs the user of an

interactive wagering opportunity without the user requesting the notification. In the parent application, the claims were amended to include a dependent claim feature that the notification is automatically displayed in response to a determination by the wagering application that the television programming is related to wagering.\* The user is provided with an opportunity to respond to the notification by pressing a remote control key on a remote control. In response to the pressing of the remote control key, the user is automatically provided with an opportunity to electronically place a wager with the interactive wagering application.

In the present divisional application, claims 1, 34, and 70 were rejected under § 102 as being anticipated by Handelman. As indicated above, applicants previously traversed this rejection in the parent application. In addition, the present Office Action's rejection of claims 1, 34 and 70 does not address the features of: (1) the notification being automatically displayed without the user requesting the notification; and (2) the notification being automatically displayed in response to a determination by the wagering application that the television programming is related to wagering. Applicants believe that these features were not addressed in the present Office Action because they were not included in the claims as originally filed in the parent application and the rejection in the present Office Action is similar to the rejection in the parent application's January 30, 2002 Office Action. Both of these features were added to

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\* As mentioned above, the dependent claims in the parent application that included this feature were parent application dependent claims 4, 45 and 85.

the claims in the parent application by amendment after the January 30, 2002 Office Action. As mentioned above, the inclusion of this second feature in the claims is what made the claims allowable in the parent application. Therefore, for at least this reason, applicants submit that claims 1, 34, and 70 should be found allowable in this divisional patent application over Handelman.

Dependent claim 73 in the present divisional application corresponds to dependent claim 85 in the parent application. This claim is the machine readable medium dependent claim that includes the allowable feature in the independent claim of the notification being automatically displayed in response to a determination by the wagering application that the television programming is related to wagering. Applicants inadvertently included this dependent claim as claim 73 in the present divisional application when filing the divisional application even though claim 85 of the parent application was cancelled. Applicants have cancelled claim 73 concurrently herewith in the application as it is redundant to the features in independent claim 70.

Even though this feature is redundant to the independent claim, the Office Action rejected it on different grounds. In particular, the Office Action rejected this claim under § 103 as being unpatentable over Handelman in view of Schein. As a reminder, this claim and this feature were never rejected under § 103 over Handelman in view of Schein in the parent application. Consistent with the prosecution in the parent application, the present Office Action admits that

Handelman does not disclose this feature.\* However, the Office Action contends that it would be obvious to use the monitoring features of Schein in Handelman. Applicants respectfully disagree.

Schein is directed to a method and apparatus for searching a guide using program characteristics. Applicants submit that it would not be obvious to one of ordinary skill in the art at the time of the invention to modify Handelman with Schein to arrive at applicants' claimed features of: displaying television programming on the user equipment; automatically displaying a notification as an overlay on top of the television programming that informs the user of an interactive wagering opportunity without the user requesting the notification, wherein the notification is automatically displayed in response to a determination by the wagering application that the television programming is related to wagering; providing the user with an opportunity to respond to the notification by pressing a remote control key on a remote control; and automatically providing the user with an opportunity to electronically place a wager with the interactive wagering application in response to the pressing of the remote control key.

Accordingly, applicants submit that claims 1, 34, and 70 should be found allowable over Handelman in view of Schein.

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\* This admission adds further credence to applicants' argument above that the rejection of claims 1, 34 and 70 under § 102 over Handelman should be withdrawn.

B. Claims 18, 55, 88

Claims 18, 55 and 88 in the present divisional application correspond with claims 23, 64 and 104, respectively, in the parent application. In the parent application, the October 7, 2002 Office Action rejected parent application claims 23, 64 and 104, but found their dependent parent application claims 25, 66 and 106, respectively, to be allowable. To place the claims in condition for allowance, the February 27, 2003 Reply to Office Action amended parent application claims 23, 64 and 104 to include the features of their dependent parent application claims 25, 66 and 106, respectively. Claims 23, 64 and 104 were then withdrawn from the parent application in response to the May 2, 2003 Restriction Requirement. These claims, in their allowable form, were filed in the divisional patent application as claims 18, 55 and 88.

In the present divisional application, claims 18, 55 and 88 were rejected under § 102 as being anticipated by Handelman. In the parent application, the corresponding claims 23, 64 and 104, along with their respective dependent claims 25, 66 and 106, were rejected in the January 30, 2002 Office Action under § 103 as being unpatentable over Handelman in view of Schein. The January 30, 2002 Office Action admitted that Handelman lacked explicitly disclosing the feature from parent application claims 23, 64 and 104 of "monitoring the user's activities at the user equipment" and the feature from dependent parent application claims 25, 66 and 106 of "monitoring the user's activities to determine which television programs the user watches." For at least this reason, applicants submit that the rejection in the present application



of claims 18, 55 and 88 under § 102 over Handelman should be withdrawn. Moreover, applicants argued in their July 1, 2002 Reply to Office Action that Handelman in combination with Schein does not show or suggest monitoring the user's activities at the user equipment. In response, the October 7, 2002 Office Action found dependent parent application claims 25, 66 and 106 allowable. The features of dependent parent application claims 25, 66 and 106 are now present in the divisional patent application claims 18, 55 and 88.

Therefore, for at least the foregoing reasons, applicants submit that the rejection of claims 18, 55 and 88 should be withdrawn.

C. Claims 31, 68, 101

Claims 31, 68 and 101 in the present divisional application correspond with claims 28, 69 and 109, respectively, in the parent application. In the parent application, the January 30, 2002 Office Action rejected parent application claim 28 for being dependent upon a rejected base claim, but stated that it may be allowable if rewritten in independent form to include all the features of the base claim and any intervening claims (see January 30, 2002 Office Action, page 11). In the July 1, 2002 Reply to Office Action, applicant amended parent application claim 28 to include all of the features of parent base claim 23. The July 1, 2002 Reply to Office Action also added parent application claims 69 and 109 as corresponding system and machine readable medium claims to parent application method claim 28. As a result, the October 7, 2002 Office Action found parent application claims 28, 69 and 109 to be allowable. Claims 28, 69 and 109 were

then withdrawn from the parent application in response to the May 2, 2003 Restriction Requirement. These claims, in their allowable form, were filed in the divisional patent application as claims 31, 68 and 101.

In the present divisional application, claims 31, 68 and 101 were rejected under § 102 as being anticipated by Handelman. The Office Action rejected claims 31, 68 and 101 contending that Handelman discloses: (1) displaying television programming on user equipment; (2) displaying a notification as an overlay on top of the television programming that informs the user of an interactive wagering opportunity; (3) providing the user with an opportunity to respond to the notification by pressing a remote control key on a remote control; (4) automatically providing the user with an opportunity to electronically place a wager with the interactive wagering application in response to the pressing of the remote control key; and (5) monitoring the user's activities to determine which types of wagers the user has made with the interactive wagering application, wherein the content of the notification depends on which types of wagers the user has made (see Office Action, pages 2-5).

Applicants submit that the rejection is improper because features 2-5 are not present in claims 31, 68 and 101. Furthermore, the Office Action did not address features that are present in claims 31, 68 and 101 when rejecting the claims. In addition, as admitted by allowing parent application claims 28, 69 and 109 in the October 7, 2002 Office Action, Handelman does not show or suggest applicants' invention of claims 31, 68 and 101 of: displaying television programming on a display of the cellular telephone; monitoring the user's activities at the

cellular telephone; displaying wagering-related promotional material on the cellular telephone in place of at least a portion of the screen of television programming wherein content of the promotional material that is displayed depends on the user's activities; and providing the user with an opportunity to respond to the promotional material by pressing a remote control key on a remote control.

Therefore, for at least the foregoing reasons, applicants submit that the rejection of claims 31, 68 and 101 should be withdrawn.

D. Claims 32, 69, 102

Claims 32, 69 and 102 in the present divisional application correspond with claims 35, 76 and 116, respectively, in the parent application. In the parent application, the January 30, 2002 Office Action rejected parent application claim 35 for being dependent upon a rejected base claim but stated that it may be allowable if rewritten in independent form to include all the features of the base claim and any intervening claims (see January 30, 2002 Office Action, page 11). In the July 1, 2002 Reply to Office Action, applicant amended parent application claim 35 to include all of the features of parent base claim 23. The July 1, 2002 Reply to Office Action also added parent application claims 76 and 116 as corresponding system and machine readable medium claims to parent application method claim 35. As a result, the October 7, 2002 Office Action found parent application claims 35, 76 and 116 to be allowable. Claims 35, 76 and 116 were then withdrawn from the parent application in response to the May 2, 2003 Restriction Requirement. These claims, in their

allowable form, were filed in the divisional patent application as claims 32, 69 and 102.

In the present divisional application, claims 32, 69 and 102 were rejected under § 102 as being anticipated by Handelman. The Office Action rejected claims 32, 69 and 102 contending that Handelman discloses: (1) displaying television programming on user equipment; (2) displaying a notification as an overlay on top of the television programming that informs the user of an interactive wagering opportunity; (3) providing the user with an opportunity to respond to the notification by pressing a remote control key on a remote control; (4) automatically providing the user with an opportunity to electronically place a wager with the interactive wagering application in response to the pressing of the remote control key; and (5) monitoring the user's activities to determine which types of wagers the user has made with the interactive wagering application, wherein the content of the notification depends on which types of wagers the user has made (see Office Action, pages 2-5).

Similar to claims 31, 68 and 101 (in subsection C above), applicants submit that the rejection is improper because features 2-5 are not present in claims 32, 69 and 102. Furthermore, the Office Action did not address features that are present in claims 32, 69 and 102 when rejecting the claims. In addition, as admitted by allowing parent application claims 35, 76 and 116 in the October 7, 2002 Office Action, Handelman does not show or suggest applicants' invention of claims 32, 69 and 102 of: displaying a screen of television programming to the user with the user equipment; monitoring the user's activities at the user equipment; collecting information on

which wagers the user has won; displaying wagering-related promotional material on the user equipment in place of at least a portion of the screen of television programming wherein content of the promotional material is related to the wagers the user has won; and providing the user with an opportunity to respond to the promotional material by pressing a remote control key on a remote control.

Therefore, for at least the foregoing reasons, applicants submit that the rejection of claims 32, 69 and 102 should be withdrawn.

E. Claims 33, 103, 104

Claims 33, 103 and 104 in the present divisional application correspond with claims 41, 122 and 123, respectively, in the parent application. In the parent application, the January 30, 2002 Office Action rejected parent application claim 41 under § 103 as being unpatentable over Handelman in view of Schein (see January 30, 2002 Office Action, pages 6 and 10-11). In the July 1, 2002 Reply to Office Action, applicant amended parent application claim 41 and argued that neither Handelman nor Schein shows or suggests the features defined in parent application claim 41. The July 1, 2002 Reply to Office Action also added parent application claims 122 and 123 as corresponding system and machine readable medium claims to parent application method claim 41. As a result, the October 7, 2002 Office Action found parent application claims 41, 122 and 123 to be allowable. Claims 41, 122 and 123 were then withdrawn from the parent application in response to the May 2, 2003 Restriction

Requirement. These claims, in their allowable form, were filed in the divisional patent application as claims 33, 103 and 104.

In the present divisional application, claim 33 was rejected under § 102 as being anticipated by Handelman and claims 103 and 104 were rejected under § 103 as being unpatentable over Handelman in view of Schein. The Office Action rejected claims 33, 103 and 104 contending that Handelman discloses: (1) displaying television programming on user equipment; (2) displaying a notification as an overlay on top of the television programming that informs the user of an interactive wagering opportunity; (3) providing the user with an opportunity to respond to the notification by pressing a remote control key on a remote control; and (4) automatically providing the user with an opportunity to electronically place a wager with the interactive wagering application in response to the pressing of the remote control key (see Office Action, pages 2-3). However, applicants submit that the rejection is improper because at least features 3 and 4 are not present in claims 33, 103 and 104. When rejecting claims 103 and 104 under § 103, the Office Action admitted that Handelman does not explicitly disclose "monitoring the user's activities to determine which television programs the user watches, where information on which programs are being watched is collected using program guide database information that is distributed to the user equipment from a program guide data source" (see Office Action, pages 7-8). Nevertheless, the Office Action contends it would be obvious to combine Schein with Handelman to show these features. However, the rejection is improper because these features are not present in claims 103 and 104. Furthermore, the Office Action did not address features that

are present in claims 33, 103 and 104 when rejecting the claims.

In addition, as admitted by allowing parent application claims 41, 122 and 123 in the October 7, 2002 Office Action, Handelman by itself and Handelman in view of Schein, do not show or suggest applicants' invention of claims 33, 103 and 104 of: receiving program schedule information for television programs from a program schedule data source; determining content of the television programming the user is watching using the program schedule information and information obtained from the user television equipment on a current time and a current channel to which the user equipment is tuned; and providing a display of a notification to the user indicating the availability of an opportunity to place an interactive on-screen wager when it is determined that the television programming is related to a subject conducive to wagering.

Therefore, for at least the foregoing reasons, applicants submit that the rejection of claims 33, 103 and 104 should be withdrawn.

#### F. Dependent Claims

Applicants submit that dependent claims 2-17, 19-30, 35-50, 56-67, 71, 72, 74-87 and 89-100 are allowable at least because they depend from one of allowable independent claims 11-18, 31-34, 55, 68-70, 88 and 101-104.

#### V. Allowable Subject Matter in Claims 52-54

Claims 52-54 were found to allowable. Claims 52-54 are dependent on independent claim 51. As mentioned above, the parent patent application was subject to a two-way restriction requirement. Applicants pursued the first claim group in the

parent application and the second claim group in the present divisional application. Claims 51-54 correspond with claims 48-51 in the parent patent application. Parent application claims 48-51 were part of the first claim group and proceeded to issuance in U.S. Patent No. 6,735,487 as claims 7-10. Applicants inadvertently filed these claims as claims 51-54 in the present divisional application, along with the other claims in the second claim group. Accordingly, applicants have cancelled claims 51-54 in the present divisional application.

The Office Action rejected claim 51 (which corresponds to parent application claim 48 and parent patent claim 7) under § 102 contending it is anticipated by Handelman because Handelman discloses: (1) displaying television programming on user equipment; (2) displaying a notification as an overlay on top of the television programming that informs the user of an interactive wagering opportunity; (3) providing the user with an opportunity to respond to the notification by pressing a remote control key on a remote control; and (4) automatically providing the user with an opportunity to electronically place a wager with the interactive wagering application in response to the pressing of the remote control key (see Office Action, pages 2-3). However, applicants submit this rejection is improper at least because feature 4 is not present in claim 51. In addition, the Office Action did not address features that are present in claim 51 when rejecting the claim.

Moreover, when allowing claims 52-54 in the present divisional application, the Office Action contends that these claims are allowable because Handelman and Brenner do not disclose, teach or fairly suggest to one of ordinary skill in

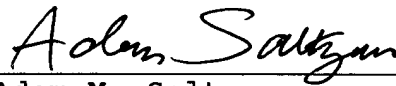


the art "automatically providing the user with an opportunity to electronically place a wager with an interactive wagering application in response to the pressing of the remote control key, wherein the user is automatically provided with interactive wagering options in which at least the racetrack has been preselected." This feature is actually found in claim 51 and is only in claims 52-54 in that claims 52-54 are dependent on claim 51. Therefore, claim 51 should have been found allowable in this case along with claims 52-54. Additionally, the same reasons for allowance were provided in the Notice of Allowance in the parent application for parent application claim 48, which corresponds with claim 51 in the present case (see December 29, 2003 Notice of Allowance, page 4). This illustrates the Examiner believes that claim 51 is allowable. Although applicants will not be pursuing claims 51-54 in this case, applicants remarks at least show that parent patent claims 7-10 are valid.

VI. Conclusion

For the reasons set forth above, claims 1-50, 55-72 and 74-104 are in condition for allowance. This application is therefore in condition for allowance. Reconsideration and allowance are respectfully requested.

Respectfully submitted,



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